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Attorney Docket No. 122.1290

10/18/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Keisuke KUBOMURA et al.

Application No.: 08/938,706 Group Art Unit: 2176

Confirmation No.: 3138

Filed: September 26, 1997 Examiner: C. Paula

For: INFORMATION PROCESSING APPARATUS AND PROGRAM STORAGE MEDIUM

REQUEST FOR ORAL HEARING

Assistant Commissioner for Patents
Washington, D.C. 2023l

Sir:

Pursuant to 37 C.F.R. §§1.194(b), applicants respectfully request oral hearing before the Board of Patent Appeals and Interferences in connection with the appeal in the subject application. The Examiner's answer was mailed on August 13, 2002, and the term for filing the request is two months from that mailing date. A check in the amount of the requisite fee of $280.00 pursuant to 37 C.F.R. §1.17(d) is enclosed.

If any additional fees are required in connection with the filing of this document, please charge Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 11 OCT 2002

By: James Strom
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THE PATENT OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

Address: 6 Xi Tu Cheng Lu, Haidian, Beijing Post Code: 100088

Applicant:	**FUJITSU LIMITED**	
Attorney:	**DU Rixin**	Date of Notification:
Application No.:	**97122591.5**	Date: 5 Month: 7 Year: 2002
Title of the Invention:	**Information Processing Apparatus And Program Storage Medium**	

Notification of the First Office Action

☒ The applicant requested examination as to substance on _____ and examination has been carried out on the above-identified patent application for invention under Article 35(1) of the Patent Law of the People's Republic of China(hereinafter referred to as "the Patent Law").

☐ The Chinese Patent Office has decided to examine the application on its own initiative under Article 35(2) of the Patent Law.

2. ☒ The applicant claimed priority/priorities based on the application(s):
filed in **JP** on **Sept. 30, 1996**, filed in **JP** on **July 9, 1997**,
filed in _____ on _____, filed in _____ on _____,
filed in _____ on _____, filed in _____ on _____,

☒ The applicant has provided the priority documents certified by the Patent Office where the priority application(s) was/were filed.

☐ The applicant has not provided the priority documents certified by the Patent Office where the priority application(s) was/were filed and therefore the priority claim(s) is/are deemed not to have been made under Article 30 of the Patent Law.

☐ The application is a PCT continuation.

3. ☐ The applicant submitted amendments to the application on _____ and on _____, wherein
the amended _____ submitted on _____ and
the amended _____ submitted on _____ are not acceptable,
because said amendments do not comply with ☐ Article 33 of the Patent Law.
☐ Rule 51 of the Implementing Regulations of the Patent Law.
The specific reasons why the amendments are not allowable are set forth in the text portion of this Notification.

4. ☒ Examination as to substance was directed to the initial application documents as filed.

☐ Examination as to substance was directed to the documents as specified below:
claims _____, pages _____ of the description and drawings _____ filed on the date of filing,
claims _____, pages _____ of the description and drawings _____ submitted on _____,
claims _____, pages _____ of the description and drawings _____ submitted on _____,
and the abstract submitted on _____.

5. ☐ This Notification is issued without search reports.

☒ This Notification is issued with consideration of the search results.

☒ Below is/are the reference document(s) cited in this Office Action(the reference number(s) will be used throughout the examination procedure):

No.	Number(s) or Title(s) of Reference(s)	Date of Publication (or the filing date of conflicting application)
1	Enabling Frame resize options during OS/2 object view swapping	Date: __ Month: 7 Year: 1994
2		Date: __ Month: __ Year: _____
3		Date: __ Month: __ Year: _____
4		Date: __ Month: __ Year: _____
5		Date: __ Month: __ Year: _____

6. Conclusions of the Action:

☒ On the Specification:

- ☐ The subject matter contained in the application is not patentable under Article 5 of the Patent Law.
- ☐ The description does not comply with Article 26 paragraph 3 of the Patent Law.
- ☒ The draft of the description does not comply with Rule 18 of the Implementing Regulations.

☒ On the Claims:

- ☒ Claim(s) 11~15 is/are not patentable under Article 25 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with the definition of inventions prescribed by Rule 2 paragraph 1 of the Implementing Regulations.
- ☐ Claim(s) _____ does/do not possess the novelty as required by Article 22 paragraph 2 of the Patent Law.
- ☒ Claim(s) 1,4,7 does/do not possess the inventiveness as required by Article 22 paragraph 3 of the Patent Law.
- ☐ Claim(s) _____ does/do not possess the practical applicability as required by Article 22 paragraph 4 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with Article 26 paragraph 4 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with Article 31 paragraph 1 of the Patent Law.
- ☒ Claim(s) 2,3,5,6,8,9 does/do not comply with the provisions of Rules 20-23 of the Implementing Regulations.
- ☐ Claim(s) _____ does/do not comply with Article 9 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with the provisions of Rule 12 paragraph 1 of the Implementing Regulations.

7. In view of the conclusions set forth above, the Examiner is of the opinion that:

- ☐ The applicant should make amendments as directed in the text portion of the Notification.
- ☒ The applicant should expound in the response reasons why the application is patentable and make amendments to the application where there are deficiencies as pointed out in the text portion of the Notification, otherwise, the application will not be allowed.
- ☐ The application contains no allowable invention, and therefore, if the applicant fails to submit sufficient reasons to prove that the application does have merits, it will be rejected.
- ☐

8. The followings should be taken into consideration by the applicant in making the response:

(1) Under Article 37 of the Patent Law, the applicant should respond to the office action within 4 months counting from the date of receipt of the Notification. If, without any justified reason, the time limit is not met, the application shall be deemed to have been withdrawn.

(2) Any amendments to the application should be in conformity with the provisions of Article 33 of the Patent Law. Substitution pages should be in duplicate and the format of the substitution should be in conformity with the relevant provision contained in "The Examination Guidelines".

(3) The response to the Notification and/or revision of the application should be mailed to or handed over to the "Reception Division" of the Patent Office, and documents not mailed or handed over to the Reception Divisions have no legal effect.

(4) Without an appointment, the applicant and/or his agent shall not interview with the Examiner in the Patent Office.

9. This Notification contains a text portion of 2 pages and the following attachments:

- ☒ 1 cited reference(s), totaling 2 pages.
- ☐

Examination Dept. 9 Examiner: Xie Jing Seal of the Examination Department

Text Portion

Claim 1 seeks to protect an information processing apparatus. Reference 1 (see the whole text) discloses an information processing method for displaying a window region corresponding to a new view, adjusted size and position when displaying different views of an object. Said method comprises the following steps: determining the optimal size for a new view when an object is requested to move from a view to another view; determining the size for the correspondent window region according to the optimal size; and displaying the new view and window region of the determined size in a screen. Differences between claim 1 and Reference 1 are: claim 1 seeks to protect an apparatus, Reference 1 discloses a method; but each part in the apparatus of claim 1 is defined completely by functions to be fulfilled, these functions are disclosed one by one by steps in the method of Reference 1, thus it is easy to obtain the apparatus of claim 1 from the method of Reference 1. Moreover, the apparatus of claim 1 displays an image and an intended area in the enlarged form, and the method of Reference 1 is used for displaying a view and a window region. That is to say, claim 1 only selects one of three technical solutions corresponding to three probabilities of enlargement, contraction and constant; and can not produce the unexpected effects. Thus, claim 1 does not have the prominent substantive features and notable progress with respect to Reference 1, and does not possess the inventiveness as required by Article 22 (3) of the Chinese Patent Law (CPL).

Words appearing in claim 2, "correcting ... upward" and "correcting ... downward", are not clear in meaning. Thus, the protection scope of claim 2 is not clear, and claim 2 does not comply with Rule 20 (1) of the Implementing Regulations (IR) of the CPL. Similarly, claims 5 and 8 can not be acceped by the same defects.

The determining means in claim 3 calculates the second magnification

rate through using a method different from the method used by the determining means in claim 1, but claim 3 is described as a dependent claim , so that the definition of the determining means in the technical solution is not consistent with each other, and the scope sought to be protected by claim 3 is not clear. Moreover, the definition of the enlarged display means in claim 3 is repeated with that in claim 1, so that claim 3 is not concise, and does not comply with Rule 20 (1) of the IR of the CPL. Similarly, claim 6 can not be accepted by the same defects.

Independent claim 4 also seeks to protect an information processing apparatus. Differences between claims 4 and 1 are only: the enlarged display means displays the character or image in the intended area, rather than the intended area itself. As said above, this feature is disclosed by Reference 1. Based on the similar reasons to those for claim 1, claim 4 also does not possess the inventiveness as required by Article 22 (3) of the CPL.

Independent claim 7 also seeks to protect an information processing apparatus. Differences between claim 7 and 4 are only: the determining means determines the size of the character in the intended area rather than the size of the intended area itself. But this feature is disclosed also by Reference 1. Thus, similarly , claim 7 does not possess the inventiveness as required by Article 22 (3) of the CPL.

The information processing apparatus of independent claim 9 only comprises the scrolling means, detection means and prohibition means. When lacking the determining means and enlarged display means, said intended area can not be displayed in an enlarged form on a screen, the following scrolling can not be performed, and the technical problems to be solved by the invention can not be solved. Thus, the technical solution described by claim 9 is not complete, lacks the indispensable technical features to solve the technical problems, and does not comply with Rule 21 (2) of the IR of the CPL. If all the technical features of claim 1 are incorporated into claim 1 to

rewrite it, the defect can be overcame,

Claims 11 – 15 seek to protect a recording medium having recorded a program for realizing an information processing apparatus. But the computer program itself belongs to rules and methods for mental activities. Thus, claims 11 – 15 can not be patented under Article 25 (1(2)) of the CPL.

A title should be put in front of each part of the specification to comply with Rule 18 (2) of the IR of the CPL.

Based on above reasons, only after a newly amended text is submitted in accordance with above comments, the examination process can be continued. When writing the new claims, the specification technical solution and abstract should be amended accordingly under Rule 18 of the IR of the CPL, and any amendment should comply with Article 33 of the CPL. Otherwise, the application will be rejected.